

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Blaise Mattie

Art Unit: 3711

Serial No.: 10/783,939

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Examiner: Mendiratta, Vishu K.

Title: **FIRE CALL BOARD GAME**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO EXAMINERS ANSWER

Sir:

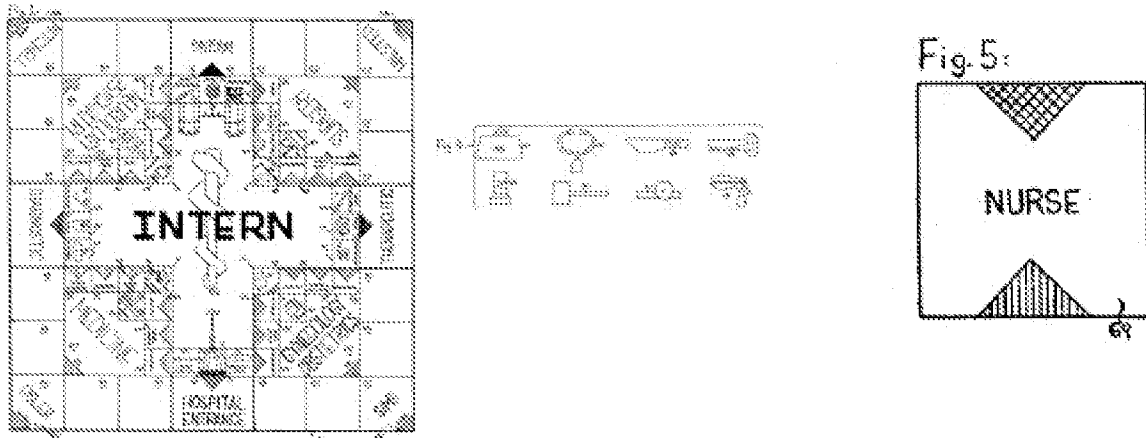
This reply brief is being filed in response to the Examiner's Answer mailed October 27, 2006.

ARGUMENT

A. Whether claims 1, 3-22 are unpatentable under 35 U.S.C. § 103(a) as being obvious over United States Patent No. 4,136,879 issued to Andrew et al., ("Andrew").

1. Overview of Andrew

Andrew teaches a board game that simulates the trials, tribulations and triumphs of an intern at a large teaching hospital. See Andrew, Abstract. Moreover, Andrew teaches a game board divided into four quadrants, representing a different medical specialty, such as medicine, neurology-psychiatry, surgery and gynecology-obstetrics. See Andrew, column 3, lines 14-17. The quadrants contain a ward which is further subdivided into spaces which represent beds in the ward. See Andrew, column 3, lines 17-20. Furthermore, the board taught by Andrew contains a continuous path divided primarily into patient spaces, diagnostic spaces, therapeutic spaces and paging spaces, in which the player navigates with a player piece corresponding to the medical specialty the player represents. See Andrew, column 1, lines 52-54, Figures 1 and 4. The number of spaces on the board that the player piece moves corresponds to the number shown on the dice. See Andrew, column 6, lines 38-40.



The Examiner restates in his Answer that “*Andrew teaches a game board (Fig.1), a plurality of markers (Fig. 4), a plurality of spaces (A1-A7 etc), start space (11), a plurality of cards (Fig. 7-12), random number generator (Fig. 3), and **badges (Fig. 5)**. Applicant may note that method steps/rules for playing the game do not further limit the apparatus in the claim.*” (Emphasis added). Nevertheless, the specification of Andrew teaches, at col. 5, line 5, facts contrary to the assertions of the Examiner:

*Referring to FIG. 5, **a typical personnel card 69** is shown and bears a brown triangle code on top and a yellow color code on bottom. Illustrated personnel card 69 bears the legend "Nurse". Twenty-eight such cards are provided with the game, **there being seven for each of the four specialties**. Thus, all 28 personnel cards are color-coded brown on top, but bear a color code corresponding to the four different specialties on the bottom. There is no printing on the reverse side of the personnel cards.*

The Examiner improperly double counts a playing card 69 of Andrew to be both a playing card and a rank badge of the instant invention, but this is improper and contrary to the teaching of BOTH the Andrew reference and the claims of the instant invention. In Andrew, prior to actual game play, each player receives an equal number of personnel cards, which corresponds to the ward they represent and contain the title of a person who would typically work in a ward, such as Attending Physician, Resident, Head Nurse, etc. See Andrew, column 6, lines 29-30, Figure 5. The personnel cards are used by the player to conceal the diagnosis and treatment cards in possession of the player from the other players. See Andrew, column 7, lines 58-60.

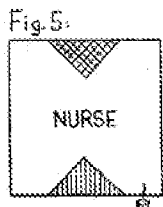
During game play, if a player lands on a patient space corresponding to that player's specialty, the patient may be admitted from the Emergency room to the corresponding specialty ward by placing that patient's card in a bed space. See Andrew, column 1, lines 61-65. Upon landing on a diagnostic or therapeutic space the player is permitted to pick up a diagnostic or therapeutic card which may or may not relate to his or her patients. See Andrew, column 1, lines 65-68.

The object of the game is for a player to: admit all of the patients relating to that player's specialty who are waiting in the emergency room by landing on each of these patient spaces; diagnosing the illness of each admitted patient by obtaining the appropriate diagnostic card; and disposing of the diagnosed patients by obtaining the appropriate therapeutic card; all while expending the minimum amount of time. See Andrew, column 1, line 68 to column 2, line 7.

Andrew is silent, and thus **does not teach or suggest** the use of rank badges because there are no different player levels whereas in the instant invention the rank badge reduces the number of equipment cards needed to complete a task based on level. Moreover, Andrew is silent, and thus **does not teach or suggest** district markers for placement on an obtained district spot to indicate ownership thereof.

B. Rejection of Claims 1, 3-22 Under 35 U.S.C. § 103(a) as Obvious over Andrew

As shown below, Andrew fails to teach or suggest of at least the element of rank badges which may be obtained by at least one player landing on a promotion space of the board and as a result of instructions indicated on a duty card. The Examiner alleges that Andrew teaches rank badges and refers to the personnel cards 69 shown in Figure 5 as evidence to support his allegation. See Final Office Action, page 2, paragraph 2. **The Examiner admits that the Appellant might argue that the personnel cards taught by Andrew are not the same as the Appellant's rank badges.** See Final Office Action, page 2, paragraph 4.



However, the Examiner further states that the only difference between the Appellant's game and Andrew resides in the meaning and information conveyed by the printed matter and is not considered patentable *Ex Parte Breslow 192 U.S.P.Q. 431*. See Final Office Action, page 2, paragraph 5. The Examiner also argues that it would have been obvious to change the information on the spaces/cards to match the theme of the game. See Final Office Action, page 2, paragraph 7. However, contrary to the Examiner's assertions the rank element of the instant invention is NOT printed matter even if the rank effects the use or interpretation of the printed material. The effect of a rank on the printed matter does not remove the element from being patentably significant. Moreover, Andrew fails to teach or obviate the element of district markers as defined in claim 3.

The Examiner alleges that Andrew teaches of rank badges and refers to the personnel cards **69** shown in Figure 5 as evidence to support his allegation. It is improper to re-characterize the personnel cards **69** taught by Andrew that are quite dissimilar in both structure and function to be the equivalent of the **rank badges** taught by the Appellant. For example, a rank badge is an emblem worn as an insignia of rank in an organization and the badge assists the player in achieving his game task goals. Andrew teaches at col. 7, line 55 that:

*All diagnosis and treatment cards are read aloud as they are obtained. They are then divided into two groups. **Those of relevance only to other interns are identified with and concealed behind one of seven personnel cards in the top row of the card rack 54.** Those of immediate or potential use to the intern who receives them are placed in the card rack in the following order: second row intradepartmental diagnosis cards; third row intradepartmental treatment cards; fourth row diagnosis cards for patients for transfer to other departments; fifth row treatment cards for patients transferred from other departments. If an intern's token lands on any of the eighteen color coded Sx (patient symptom) spaces within another department, **he is obliged to surrender any diagnostic or therapeutic card behind any personnel card specifically requested by that department's intern in exchange for one hour of time (rendered to the time bank).***
(Emphasis added)

Twenty-eight personnel cards, seven for each of the four specialties are provided in the game taught by Andrew. See Andrew, column 5, lines 8-10. There is nothing to teach or suggest that the personnel cards of Andrew are insignia's to be worn as would a badge nor do they effect a player's status as they are all used equally by players and they only serve to conceal diagnosis and treatment cards. Conversely, 20 color coded Fire Service Badges are provided in the present invention. See Application, page 7, lines 9-10.

The seven personnel cards, taught by Andrew, for each specialty are identified by the title of an individual typically found working in a hospital ward. For example, cards identified by the titles: Attending Physician, Resident, Head Nurse, Nurse, Secretary, and Orderly are provided as the personnel

cards common to all wards and a Social Worker card specific to Medicine, Physical Therapist card specific to Neurology-Psychiatry, Physician's Associate card specific to Surgery and Dietitian card specific to Gynecology Obstetrics are also provided. See Andrew, column 9, lines 23-28. Conversely, the Appellant's Fire Service Badges corresponds to a particular rank within the Fire Service. For example, the lowest rank a player can have is Firefighter, which is represented by ownership of a black Fire Service Badge, whereas ownership of a red badge indicates the highest rank of Fire Chief. Intermediate ranks of Lieutenant, Captain, and Deputy Chief are represented by ownership of Fire Service Badges colored coded white, blue and yellow, respectively. See Application, page 11, lines 10-15.

To establish a *prima facie* case for obviousness it must be shown that the cited references teach or suggest each element of the claim. See In Re Reinhart, 189 U.S.P.Q. 143, 147 CCPA, 1976 (“*prima facie*’ case of obviousness is established where the teachings from the prior art itself would have suggested the claimed subject matter”). There is no teaching regarding ranking in Andrew and thus each and every element of the instant invention is not taught.

The personnel cards taught by Andrew are equally distributed to each player at the beginning of the game depending on the number of players playing the game which is in direct contradiction to the instant invention that requires the player to land on a promotion space. See Andrew, column 6, lines 29-31. For example, if four individuals are playing the game taught by Andrew, each will receive seven personnel cards corresponding to the ward in which they have elected to be the intern thereof. These personnel cards are neither obtained nor discarded during play. In other words, the number of personnel cards received by the player at the beginning of the game remains with that player throughout the game and the number of personnel cards received at the outset of the game is only determined by the number of players playing the game. For example, if four or less players are playing, each player will receive the maximum number of seven personnel cards. Alternatively, if more than four players are playing, the personnel cards are divided equally between the players. In other words, if six players were engaged in the game, each player would receive three personnel cards and at least two players would have personnel cards from the same specialty or ward. The mere fact that one player has the personnel cards entitled Attending Physician, Resident, and Head Nurse and another player has the personnel cards entitled Nurse, Secretary, and Orderly does not have any bearing on the way the game is played or any progressive status (or rank) of the player with respect to the other players.

At the beginning of the game described and claimed by the Appellant, each player receives one rank badge representing the rank of Firefighter. See Application, page 7, lines 22-23. At the outset of the game, each player receives the same rank (i.e. Firefighter), since the rank (or progressive status) of the player materially effects the way the game is played. During play, a player attempts to obtain a higher

rank then the one currently held, with the ultimate goal of achieving the rank of Fire Chief. See Application, page 7, lines 24-35. During the course of a game, a player can be either promoted or demoted by exchanging their current rank badge for either a rank badge corresponding to a higher rank in the fire service or a rank badge of lower rank in the fire service. See Application, page 15, lines 23-25. In other words, at any given time during the course of play, the player will have no more than one rank badge in their possession. The player cannot be demoted to a rank lower than Firefighter and promoted to no higher than Fire Chief. See Application, page 7, lines 24-35. The various ranks are obtained by the player either landing on the space that says "Fire Service Promotion" or through the instructions provided on a Station Duties card. See Application, page 15, lines 22-2. Regardless, the ranking is signified by a badge that is a physical element of the game and not merely an instruction or rule.

As mentioned above, the personnel cards taught by Andrew have no bearing on the way the game is played. To reiterate, the sole function of the personnel cards taught by Andrew is concealing the diagnosis and treatment cards in the possession of the player from the other players. See Andrew, column 7, lines 58-60, and claim 7. The titles on the personnel cards with of Andrew has absolutely no effect on the way the game is played or the progressive status of the player with respect to the other players. In fact, any means capable of concealing the diagnostic and treatment cards in the possession of the player could be used to achieve the same result as the personnel cards. These concealing means could be simply the cards turned over. The fact that Andrew has elected to define these cards as personnel cards has no relevance to Appellant's claimed rank badges. Furthermore, while the Examiner stated in his Answer that *"modifying a task/space card to include a doctor's or a nurse's duties will not in spirit and scope change the configuration of task space/card,"* this argument is irrelevant to the patentability of the instant invention since Andrew is both silent regarding the physical ELEMENT of a rank badge and any difference in rules regarding an experience ranking or progressive player status.

Appellant's rank badges correspond to a progressive status in the fire service and each player starts the game with one rank badge corresponding to the lowest rank in the fire service, i.e. Firefighter. The rank of the player within the fire service, determined by the type of rank badge possessed by the player, dictates how many items of fire service equipment are required by that player to respond to a particular task. See Application, page 3, lines 27-28. The ranking by a badge that effects other requirements is an essential element to the instant claimed invention that is not MERELY related to printed matter as ranking performs the task of providing an additional randomness generating factor by changing the players required actions and standing based on rank. The Examiner states in his Answer that *"the only difference between applicant's game and the applied reference resides in meaning and information conveyed by the printed matter and not considered patentable EX. Parte Breslow 192 USPQ*

431.” (Emphasis added). The Examiner’s interpretation that the only difference between the instant invention and Andrew is printed matter is based upon ignoring the actual ranking element of the instant invention and improperly redefining the physical nature of the claimed element and its ability to further provide a function of randomness based solely upon its effect on printed matter.

The Examiner’s response to Appellant’s argument that rank badges are not disclosed by Andrew is that “*the argument pertains to method of playing and as in intended use of the limitation and does not further the claimed apparatus.*” This is an evasive response by the Examiner as it fails to address the lack of teaching in Andrew and the nature of the claimed element. The Examiner states that “[o]n page 9, the applicant argues “*the rank of the player effects the way the game is played*” is not taught in Andrew. Examiner again takes the position that the arguments are towards intended use of the limitation and not furthering the apparatus in the claim.” For the reasons stated above, Appellant strongly asserts that Andrew does not disclose or obviate the rank badges described and claimed because it does not teach an element, like the claimed rank badge, that generates an additional feature of randomness by attempting to simulate the effect of experience. A random number generator, such as dice, do not become printed matter merely for their effect on the other elements of the game, NOR do they cease to be an apparatus because they don’t function as intended unless rolled by the players. Moreover, the differences between the personnel cards disclosed by Andrew, used solely to obscure cards, and the rank badges structurally embodied by insignia patches (see FIG. 8) in the present application are more significant to the invention than mere differences in the printed matter.

Further patentable distinction between the board game of the instant invention and Andrew can be found in claim 3. The Appellant’s board game describes and claims a plurality of **district markers**, which are separate from the plurality of player markers for placement on an obtained district spot to indicate ownership thereof, regardless of whether the district spot was previously owned or not. The Examiner in the answer identified what he considers to be the equivalent of the district markers of the present invention in the Andrew reference to be Fig. 4. However, the Examiner’s interpretation is improper because it utilizes the same sole element of Andrew in place of two distinct claim elements in

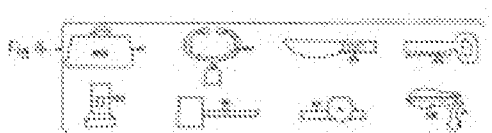


FIG. 5



FIG. 6

the instant invention having DIFFERENT structure, uses, and functions.

The Appellant has carefully studied the Andrew reference and cannot find within the reference any direct disclosure or implied suggestion of district markers or similar elements. The player pieces of Fig. 4 represent a player. The district markers (above in Fig.6) taught in the Appellant's application are separate and distinct from Appellant's taught player pieces (above in Fig. 5). Each player, in Appellant's claimed invention, may receive 10 district markers (Fig. 6) corresponding to the color of the Fire Department they have elected to represent. See Application, page 7, lines 14-15. An object of the game is to occupy as many district spots as possible by successfully responding to a Fire Call and placing a district marker on the corresponding district spot. See Application, page 11, lines 19-20. If the district spot has already been covered by another opponent's district marker, the player removes the opponent's district marker and places his/her own marker on the district spot. The game is over once all the district spots are covered and one Fire Department holds a majority of the districts. See Application, page 8, lines 25-26. However, the district markers are distinct from the player pieces (Fig. 5). Conversely, Andrew does not teach or obviate a marker that is placed on the game board to identify that a task has been successfully completed and a certain space is owned, either permanently or temporarily, by the player. Moreover, the game taught by Andrew is not won by the player who occupies the most number of spaces on the board. Instead the game taught by Andrew is ended when one player, or intern, has discharged or transferred all of his/her patients, represented by the cards shown in Figure 7. See Application, column 8, lines 30-31. The winner of the game is determined by the player who has the highest score once the scores for each player have been tabulated using a complex formula for determining the winner. See Andrew, column 8, lines 32-44.

Accordingly, Appellant respectfully submits, Andrew fails to teach or suggest every element of Claim 1 or its dependent claims. Since each and every element of Claims 1, 3-22 are not taught or suggested by the reference of record, a *prima facie* case of obviousness has not been established. For at least the foregoing reasons, Appellant respectfully submits Claims 1, 3-22 are separately patentable and requests the final rejection under 35 U.S.C. § 103(a) over Andrew be overturned.

The Examiner's position, briefly stated, is that the features recited in the rejected claims, which clearly distinguish the claimed subject matter from the prior art, do not render the claims patentable because they are all printed matter and intended use and that the claimed subject matter thereof would be obvious to a man skilled in the art. There are many game patents that differ only by elements that the Examiner conveniently classifies as being merely printed matter and in this regard, it is respectfully urged that the Examiner has demonstrated an error of interpretation between the facts at hand and the requirements of patent law in refusing to properly appreciate the presence of Appellant's distinct claim elements that are clearly and patentably separate from the teachings of Andrew.

CONCLUSION

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any additional shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 19-0513 and please credit any excess fees to such deposit account.

Respectfully submitted,

Date: December 22, 2006

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